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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,717	11/07/2001	Richard Bryan Sagar	US 018168 (D8333-08)	4154

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EXAMINER
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WOOD, WILLIAM H

ART UNIT	PAPER NUMBER
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2193

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/035,717	<b>Applicant(s)</b> SAGAR, RICHARD BRYAN	
	<b>Examiner</b> William H. Wood	<b>Art Unit</b> 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/7/01;10/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-20 are pending and have been examined.

#### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 07 November 2001 and 23 October 2003 were considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites the limitation "the third computer". There is insufficient antecedent basis for this limitation in the claim. This claim is likely intended to be dependent upon claim 12 and is interpreted as such. Claims 8-9 recites the limitation "the music data descriptors". There is insufficient antecedent basis for this limitation in the claim. This claim is likely intended to be dependent upon claim 7 and is interpreted as such.

#### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-6 and 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hightower** et al. (USPN 6,416,412).

Claim 1

**Hightower** disclosed a system for providing audio electronically that is sensitive to a context of a software environment of which the audio is a part, comprising:

a. a first computer operatively connected to a data network, the first computer comprising category data representative of a plurality of categories of audio, the categories associatable with a context of executable software (*figure 3, elements 16; column 5, lines 10-19; column 9, lines 24-28; column 9, lines 55-67, table 1*);

b. a second computer operatively connected to the first computer via the data network, the second computer executing at least a portion of the executable software, the second computer further having access to a plurality of local audio data files, each audio data file being associatable with at least one of the categories (*column 2, lines 20-24, receiving indication of other computers sound state*); and

c. selection software at least a portion of which is executing in the second computer and responsive to category data sent by the first computer in response to the context to select an audio data file local to the second computer for reproduction at the second computer (*column 9, lines 45-55, selecting and playing stored sounds in response to other computers sound state; and figure 7*).

Claim 2

**Hightower** disclosed the system of claim 1 wherein the local audio data file is at least one of an audio data file present on a storage medium directly connected to the second computer and an audio data file present on a storage

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medium accessible to the second computer via a local area network (*column 9, lines 54-55, "sounds" must be stored in some manner*).

Claim 3

**Hightower** disclosed the system of claim 1 wherein the audio data file comprises at least one of music data files and voice data files (*column 9, lines 55-67, "Beep" and "Look out"*).

Claim 4

**Hightower** disclosed the system of claim 3 wherein the music data file comprises high quality music data files (*column 9, lines 55-67, relative terminology*).

Claim 5

**Hightower** disclosed the system of claim 1 wherein the executable software is game software (*column 2, lines 20-24*).

Claim 6

**Hightower** disclosed the system of claim 1 wherein the data network comprises at least one of the Internet accessed via modem, the Internet accessed via routers, and local area networks (*figure 3*).

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Claim 10

**Hightower** disclosed the system of claim 1 further comprising categorization software executable at the second computer, the categorization software capable of locating and categorizing audio files accessible to the second computer (*figure 5, manipulate local game system sound state*).

Claim 11

**Hightower** disclosed the system of claim 10 wherein the categorization software is selected from the group of categorization software consisting of software capabilities in the game application, software external to the game application, and software that comprises one or more operating system services (*column 2, lines 20-24; game software*).

Claim 12

**Hightower** disclosed the system of claim 1 further comprising (*substantially the same as for claim 1*):

a. a third computer operatively connected to the first computer via the data network, the third computer executing at least a portion of the executable software, the third computer further having access to a plurality of local audio data files, each audio data file being associated with at least one of the categories, the third computer operatively connected to the second computer

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via the data communication network (*figure 3, element 16, another game system*); and

b. selection software at least a portion of which is executing in the third computer and responsive to category data sent by the first computer in response to the context to select an audio data file local to the third computer for reproduction at the third computer (*column 9, lines 45-55, selecting and playing stored sounds in response to other computers sound state; and figure 7*).

Claim 13

**Hightower** disclosed the system of claim [12] wherein:

a. the first computer is a game server computer (*figure 3, elements 18 and 30*);

b. the executable software is game software (*column 2, lines 20-24*); and

c. the selection software executing in the second computer and the third computer is responsive to category data sent by the first computer to select an audio data file local to the second computer for reproduction at the second computer and to select an audio data file local to the third computer for reproduction at the third computer (*as for claims 1 and 12*);

d. wherein the first computer selects the categories based at least in part on a context of the game software executing in at least one of the second computer and the third computer for game play between the second computer



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and the third computer (*as for claims 1 and 12*).

Claim 14

**Hightower** a method of producing audio during execution of software on a system of claim 1, comprising:

a. at predetermined intervals, determining a context of a state of the software executing in the second computer by the first computer (*figure 7, receive sound state from other computers*);

b. selecting a category at the first computer in response to the context, the category associated with the context (*column 9, lines 39-54*);

c. transmitting the category to the second computer (*figures 5 and 6; column 2, lines 20-24; based on further game play and the previous sound state received, transmit any new states from current game system to other game systems*);

d. selection of an audio data file accessible locally to the second computer by the selection software at the second computer in response to the category transmitted to the second computer (*column 9, lines 54-67*); and

e. reproduction of audio using the audio data file by the second computer (*column 9, lines 54-67*).

Claim 15

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**Hightower** disclosed the method of claim 14, wherein step (b) further comprises:

- i. allowing a user to select a subset of categories from a set of categories (*column 9, lines 54-67*); and
- ii. allowing the user to associate the selected subset of categories with one or more contexts for use during execution of the executable software at the second computer (*figure 7, transmitting state between game systems*).

Claim 16

**Hightower** disclosed the method of claim 15, wherein step (b) further comprises storing the associations at the first computer for use during execution of the executable software at the second computer (*figure 7, element 410, store sound bits from other systems on current system*).

Claim 17

**Hightower** disclosed the method of claim 14 wherein the executable software at the second computer comprises audiovisual software (*column 5, lines 10-19*).

Claim 18

**Hightower** disclosed the method of claim 14 further comprising creating a set of categories during at least one of concurrently with selection software execution, at the initiation of the selection software, when the selection

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software is first installed, when the selection software is updated, and periodically at predetermined intervals (*column 9, lines 54-67, when first installed at least*).

Claim 19

**Hightower** disclosed the method of claim 14 further comprising:

- a. locating audio files accessible to the second computer (*column 9, lines 54-55, sounds must be stored in some manner*); and
- b. categorizing the located audio files into categories compatible with categories transmitted to the second computer (*column 9, lines 55-67*).

Claim 20

**Hightower** disclosed a computer program embodied within a computer-readable medium created using the method of claim 14 (*column 5, lines 10-19, software and hardware for carrying out games*).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hightower** et al. (USPN 6,416,412) in view of **Burton** et al. (USPN 5,902,947).

Claim 7

**Hightower** did not explicitly state the system of claim 1, further comprising:

- a. musical data descriptors local to the first computer; and
- b. a music generator local to the second computer, the music generator responsive to the music data descriptors to generate music at the second computer.

**Burton** demonstrated that it was known at the time of invention to make use of musical data descriptors (column 5, lines 45-54) and thus generation of sound through them. **Hightower** demonstrated sending between gaming machines sound data (see above under claim 1). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the game machine sounds as a MIDI file as found in **Burton's** teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make use of a common sound format, which is thus easy to implement.

Claim 8

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**Hightower** and **Burton** disclosed the system of claim [7] wherein the musical data descriptors comprise MIDI formatted data (**Burton**: column 5, lines 45-54).

Claim 9

**Hightower** and **Burton** disclosed the system of claim [7] wherein the musical data descriptors are sent by the first computer to the second computer (**Hightower**: column 2, lines 20-24).

**Correspondence Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 10:00am - 4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571)-272-3756. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



William H. Wood  
Patent Examiner  
AU 2193  
December 19, 2006